



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/639,508 08/16/00 CHOMIK

R 460.1891USV

EXAMINER

QM12/0322

CHARLES N.J. RUGGIERO ESQ
OHLANDT GREELEY RUGGIERO & PERLE LLP
ONE LANDMARK SQUARE
STAMFORD CT 06901-2682

DEXTER, C
ART UNIT

PAPER NUMBER

3724
DATE MAILED:

03/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/639,508

Applicant(s)
Chomik et al.

Examiner
Clark F. Dexter

Group Art Unit
3724



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 14-40 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 14-40 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3724

DETAILED ACTION

1. The fax communication filed February 5, 2001 has been received. However, upon careful reconsideration, further restriction is required.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 14-16, 18-20 and 24-26, drawn to a method of forming a plurality of perforations with a specific slit size, classified in class 215, subclass 11.5.
 - II. Claims 14-16, 21-23, 27-29 and 37-39, drawn to a method of forming a plurality of perforations with a specific forming step, classified in class 83, subclass 30.
 - III. Claims 14-16, 37 and 40, drawn to a method of forming a plurality of perforations with a specific flattening step, classified in class 83, subclass 17.
 - IV. Claims 17 and 30-36, drawn to a perforating apparatus, classified in class 83, subclass 660.
3. Claims 14, 15 and 18-23 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the specific slit size of Group I). It is noted that if claim 14 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 14, 15 and 18-23 will be considered. The same applies to claims 16 and 17 with respect to the claims dependent therefrom. It is further noted that while claims

Art Unit: 3724

14-16 are listed as part of three groups, they are not considered to be part of any of these groups. Rather, claims 14-16 recite subject matter that is common to these groups and has been shown as part of each group for clarity (i.e., so that it is clear which claims are part of which group). Further, because claims 14-16 include subject matter which is common to the three groups, they are not considered to be independent or distinct from any one of these groups. Therefore, claims 14-16 will be examined with an elected one of these groups. The same applies to claim 37 with respect to groups II and III.

4. The inventions are distinct, each from the other because of the following reasons:

Method vs Apparatus

5. Inventions I-III are related to invention IV as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process; for example, the apparatus can be used to punch various types of work pieces.

Method Groups I-III

6. Inventions of groups I and II are separate inventions. They are distinct because the invention of group I does not require the specific details of the forming step of group II for

Art Unit: 3724

patentability as evidenced by the omission thereof from group I, and the invention of group II does not require the specific details of the slit size of group I for patentability as evidenced by the omission thereof from group II.

7. Inventions of groups I and III are separate inventions. They are distinct because the invention of group I does not require the specific details of the flattening step of group III for patentability as evidenced by the omission thereof from group I, and the invention of group III does not require the specific details of the slit size of group I for patentability as evidenced by the omission thereof from group III.

8. Inventions of groups II and III are separate inventions. They are distinct because the invention of group II does not require the specific details of the flattening step of group III for patentability as evidenced by the omission thereof from group II, and the invention of group III does not require the specific details of the forming step of group II for patentability as evidenced by the omission thereof from group III.

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 3724

Species

10. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A - Figure 4;

Species B - Figures 5-8A.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 14-16 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

Art Unit: 3724

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.


11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.


Clark F. Dexter
Primary Examiner
Art Unit 3724

cfid
March 21, 2001